

## **II. REMARKS**

The second non-final Office Action in this application, dated May 19, 2008 (hereinafter “Second Non-Final Action”), and the references cited therein have been carefully reviewed. This submission is intended to be fully responsive to the Second Non-Final Action. Claims 1-13 are pending in the application; all pending claims presently stand rejected. In addition, claims 4, 6 and 11-13 are objected to by the Examiner. Applicants have amended claims 1-3, 5 and 8-13 merely to correct certain formalities. After entering this submission, claims 1-13 remain pending. Reconsideration and allowance of the present application in view of the above amendments and the following remarks is respectfully requested.

### **A. EXAMINER’S RESPONSE TO ARGUMENTS**

Applicants have reviewed the Examiner’s “Response to Arguments” section, and acknowledge that the remarks with respect to the pending claims submitted in Applicants’ “Response under 37 C.F.R. § 1.111” on January 28, 2008, at 6-8, have been evaluated by the Examiner, but are considered to be “moot in view of the new ground(s) of rejection”. Second Non-Final Action, at 5, Item No. 22.

### **B. OBJECTIONS TO THE CLAIMS**

Claims 1 and 8 are objected to for certain informalities. First, claim 1 recites the limitation “moveable” in line 4; the Examiner finds that “‘moveable’ should be [replaced by] ‘movable’.” Second Non-Final Action, at 2, Item No. 2. Second, “[i]n claim 8, on lines 3 and 9, ‘moveable’ should perhaps be [replaced by] ‘movable’ for consistency.” *Id.*, Item No. 3. In accordance with the Examiner’s recommendations, corrections have been made to claims 1, 8 and 12, to replace any recitation of the limitation “moveable” with “movable”. In light of the corrections noted above, Applicants respectfully request withdrawal of the objections to claims 1 and 8.

### **C. CLAIM REJECTIONS – 35 U.S.C. 112**

Claims 1-6 and 9-13 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention.

As part of the 112, ¶2, rejection, the Examiner first observes that claim 1 recites “the movable cover part ‘can be’ moved up (lines 4-5)”, and that “the drive element is arranged on a holding device that ‘can be’ mounted on the auto body (lines 6-7).” Second Non-Final Action, at 2, Item No. 6. Thereafter, the Examiner concludes that “[t]he limitations ‘can be’ are indefinite and vague as to what the applicant intends to recite.” Id. Claims 2, 3 and 5 are also rejected under 112, ¶2, for reciting the limitation “can be”. See Id., Item Nos. 7-9. In response, Applicants have corrected claims 1, 2, 3 and 5 to eliminate any recitation of the limitation “can be”.

Secondly, the Examiner points out that claims 9 and 10 both recite the limitation “the vehicle body”, while claim 12 recites the limitation “said first and second positions”. See Id., Item Nos. 10-12. The Examiner then notes that there is insufficient antecedent basis for these limitations in the claims. Responsively, Applicants have made appropriate corrections to the claims to provide proper antecedent basis throughout.

In light of the amendments and remarks set forth above, Applicants respectfully request withdrawal of the 35 U.S.C. § 112, ¶2, rejections of claims 1-6 and 9-13.

#### **D. DOUBLE PATENTING**

Claims 9, 10 and 13 are objected to under 37 C.F.R. § 1.75 as being a substantial duplicate of claims 2, 3 and 6, respectively. See Second Non-Final Action, at 3, Item No. 14. Applicants note, due to an inadvertent scrivener’s error, previously presented claims 9, 10 and 13 unintentionally depend from independent claim 1. In order to correct this mistake, and also eliminate any double patenting issues, Applicants have amended claims 9-13 to depend from base claim 8. As such, Applicants respectfully request withdrawal of the objection to claims 9, 10 and 13 under 37 C.F.R. § 1.75.

#### **E. CLAIM REJECTIONS – 35 U.S.C. 102**

Claims 1-3, 5 and 8-10 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Appl. Publication No. 2002/0171258 A1, to Obendiek (hereinafter “Obendiek”).

The Examiner collectively rejects claims 1-3, 5 and 8-10 under § 102(b) finding that the Obendiek reference anticipates the inventions respectively claimed therein. Specifically, the Examiner finds that Obendiek discloses:

a convertible vehicle having an auto body with a movable roof 2 and at least one movable cover part 6 that covers a receiving area for the roof situated in the auto body when the at least one movable cover part is in a closed position and the movable roof is in an open position, and which can be moved up by at least one drive element 3, characterized in that the drive element is arranged on a holding device 1 that can be mounted on the auto body, which is also a support for at least one control unit 9, a hydraulic pump 8 and inherently connections of control lines leading to drive units for roof movement. Second Non-Final Action, at 4, Item No 17 (emphasis added).

Applicants' respectfully traverse the pending 102 rejection of claims 1-3, 5 and 8-10 as unsupported by the record and, therefore, improper.

Invalidity on the grounds of anticipation "requires lack of novelty of the invention as claimed. . . . that is, all of the elements and limitations of the claim must be shown in a single prior reference, arranged as in the claim." Karsten Manufacturing Corp. v. Cleveland Golf Co., 242 F.3d 1376, 1383 (Fed. Cir. 2001). According to MPEP and judicial directives, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131, citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631 (Fed. Cir. 1987). ) It is not sufficient that a reference ostensibly appears to illustrate an applicant's claimed invention. Rather, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131, citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236 (Fed. Cir. 1989). The prior art of record fails to disclose each and every element and limitation of Applicants' claimed inventions.

Independent claims 1 and 8 recite at least one element and numerous limitations that are not anticipated by the Obendiek reference. In particular, claim 1 recites "a holding device (9) that is configured to be mounted on the auto body", and is adapted to support "at least one drive element (8)", in addition to "at least one control unit (12), a hydraulic pump (16) and connections (14) of control lines (21) leading to drive units (4) for roof movement." (Emphasis added.) Claim 8 recites similar elements and limitations. Unlike Applicants' claimed holding device 9, Obendiek's holding device, identified by the Examiner as main bearing 1, is not depicted or described anywhere in the reference as a support for a control unit, a hydraulic pump, and connections of control lines that lead to drive units for roof movement. The Examiner has erroneously identified Obendiek's front roof part 8 as "a hydraulic pump", linkage 9 as "a control unit", and failed to provide any extrinsic support on the record for the contention that the

“connections of control lines” are “inherently” disclosed in the Obendiek reference. See Second Non-Final Action, at 4, Item No. 17. Accordingly, Obendiek is insufficient prior art upon which to premise a 102 rejection of claims 1 and 8, or any claims that respectively depend therefrom.

Obendiek also fails to anticipate pending claims 2, 3, 9 and 10, even when evaluated separately from independent claims 1 and 8. That is, Obendiek does not anticipatorily depict or describe the holding device (9) being “configured to be preinstalled outside of the auto body and checked for function of both the at least one drive element (8) for the cover part (7) and the drive units (4) for moving the roof”, as similarly set forth in claims 2 and 9, or the holding device (9) being “configured to be installed in a side receptacle of the auto body in front of or behind a wheel well (10)”, as similarly required by claims 3 and 10. Remarkably, the Examiner has completely failed to address any of the limitations presented in claims 2, 3, 9 and 10, let alone indicate where in the prior art of record such limitations may be found.

In view of the remarks presented above, Applicants request reconsideration and withdrawal of the § 102(b) rejection of claims 1-3, 5 and 8-10 based upon the Obendiek reference.

Claim 7 is rejected under 35 U.S.C. § 102(b) as being anticipated by International (PCT) Appl. Publication No. WO 2002/43978 A2, to Rawlings et al. (hereinafter “Rawlings”).

In rejecting independent claim 7, the Examiner finds that Rawlings discloses “a multifunctional holding device 32” which meets all of the limitations of Applicants’ claimed holding device (9). Second Non-Final Action, at 4, Item No. 19. However, the Examiner has not indicated where in Rawlings the body-mounted mounting bracket 32 is disclosed as having “several connection flanges” that are designed “to accommodate at least one control unit [], a pump [], and connections [] for emerging hydraulic lines []”, in addition to being characterized “as a support for at least one drive element [] for a cover part [] of a compartment top of a convertible vehicle”, as required by Applicants’ claim 7. Applicants have reviewed the entire Rawlings reference and were unable to locate a single recitation or depiction of a control unit, a pump, connections for emerging hydraulic lines, or similar structure, let alone a holding device that has “several connection flanges” adapted to “accommodate” such structure. Consequently, Rawlings is not sufficient proper prior art for rejecting claim 7 under Section 102 of Title 35.

In light of the remarks presented above, Applicants request reconsideration and withdrawal of the § 102(b) rejection of claim 7 based upon the Rawlings reference.

**F. ALLOWABLE SUBJECT MATTER**

Claims 4, 6 and 11-13 are deemed “allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph,” highlighted above, “and to include all of the limitations of the base claim and any intervening claims.” Second Non-Final Action, at 5, Item No. 21.

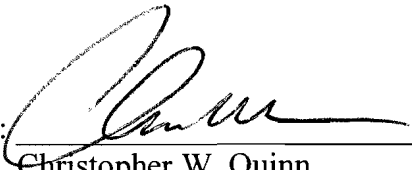
Applicants respectfully submit, however, that claims 4 and 6 and claims 11-13 are allowable for at least those reasons as independent claims 1 and 8 set forth hereinabove, *supra* § II.B-E, at 5-8, from which they respectively depend.

**III. CONCLUSION**

In light of the amendments and remarks set forth above, this submission is believed to be fully responsive to the Office Action, dated May 19, 2008. The amendments and remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is herein respectfully requested. In the event formal matters remain, the Examiner is respectfully encouraged to call the undersigned at her soonest convenience to discuss those matters before any further action is taken.

Respectfully submitted,

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Date: 8/5/08

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